

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of :  
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Christian S. SEIFERT : Confirmation No. 1691  
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Serial No. 10/642,506 : Group Art Unit: 2176  
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Filed: August 18, 2003 : Examiner: Andrea Natae LONG  
:  
For: GRAPHICAL USER COMPUTER INTERFACE

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
U.S. Patents and Trademarks Office

Attn: BOARD OF PATENT APPEALS AND INTERFERENCES

**APPELLANT'S BRIEF UNDER 37 C.F.R. § 41.37(c)**

This brief is in furtherance of the Notice of Appeal, filed in this case on July 23, 2007 and Notice of Panel Decision from Pre-Appeal Brief Review mailed November 2, 2007.

The fees required under § 41.20 and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

Only one copy of this brief is required under § 41.37.

This brief contains these items under the following headings, and in the order set forth below (*37 C.F.R. § 41.37(c)*):

- I. Real Party in Interest.
- II. Related Appeals and Interferences.
- III. Status of Claims.
- IV. Status of Amendments.
- V. Summary of Claimed Subject Matter.
- VI. Grounds of Rejection to be Reviewed on Appeal.
- VII. Argument.
- VIII. Claims Appendix.
- IX. Evidence Appendix.
- X. Related Proceedings Appendix.

The final page of this brief bears the attorney's signature.

### **I. REAL PARTY IN INTEREST**

The real party in interest in this appeal is Hewlett-Packard Development Company, L.P., a Texas limited partnership.

### **II. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal.

### **III. STATUS OF CLAIMS**

#### **A. Total Number of Claims in Application**

There are a total of 24 claims in the application, which are identified as claims 1-24.

#### **B. Status of all the claims**

1. Claims cancelled: none
2. Claims withdrawn from consideration but not cancelled: none
3. Claims pending: claims 1-24
4. Claims allowed: none
5. Claims rejected: claims 1-5 and 7-24
6. Allowable claims: claim 6

#### **C. Claims on Appeal**

Claims on appeal are claims 1-5 and 7-24 as rejected by the Final Office Action dated

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#### **IV. STATUS OF AMENDMENTS**

No Amendment was filed in response to the Final Office Action.

#### **V. SUMMARY OF CLAIMED SUBJECT MATTER**

For the purpose of this appeal brief only, the claimed subject matter will be explained herein below with references to the specification by page and line number, and to the drawings by reference characters.

The invention of **independent claim 10** is directed to a graphical user computer interface (10 in FIG. 1) enabling a user to open at least one menu (12 in FIG. 1) and to select an item (14 in FIG. 1) of the menu (12) by means of a pointing device (30 in FIG. 5, as well as FIGs. 6a, 6b and 7), the pointing device (30) controlling a moveable pointer (16 in FIG. 1) and a moveable menu item focus (18 in FIG. 1).<sup>1</sup> The interface (10) is arranged such that, after the menu (12) has been opened, the pointer (16) stays at the position it was in when the menu (12) was opened, while the menu item focus (18) is moveable within the menu (12) by means of the pointing device (30) without moving the pointer (16).<sup>2</sup>

The invention of **independent claim 18** is directed to a computer (20 in FIG. 5) comprising a display (22 in FIG. 5) and a pointing device (30 in FIG. 5).<sup>3</sup> The computer (20) is programmed to provide a graphical user interface (10 in FIG. 1) enabling a user to open at least one menu (12 in FIG. 1) in the display (22) and to select an item (14 in FIG. 1) of the menu (12) by means of the pointing device (30).<sup>4</sup> The pointing device (30) controls a moveable pointer (16 in FIG. 1) and a moveable menu item focus (18 in FIG. 1).<sup>5</sup> After the

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<sup>1</sup> Specification at page 7, lines 15-17 and page 8, lines 22-23.

<sup>2</sup> Specification at page 8, lines 20-23.

<sup>3</sup> Specification at page 16, lines 6-8.

<sup>4</sup> Specification at page 16, lines 8-14 and page 7, lines 15-17.

<sup>5</sup> Specification at page 7, lines 15-17 and page 8, lines 22-23.

menu (12) has been opened and while the menu is being opened,<sup>6</sup> the pointer (16) stays at the position it was in when the menu (12) was opened, while the menu item focus (18) is moveable within the menu (12) by means of the pointing device (30) without moving the pointer (16).<sup>7</sup>

The invention of **independent claim 20** is directed to a computer-readable medium containing thereon program code<sup>8</sup> which, when executed on a computer system (20 in FIG. 5), is arranged

to enable a user to open at least one menu (12 in FIG. 1) in a display (22 in FIG. 5) of the computer system (20) and to select an item (14 in FIG. 1) of the menu (12) by means of a pointing device (30 in FIG. 5) of the computer system (20),<sup>9</sup>

to enable the pointing device (30) to control a moveable pointer (16 in FIG. 1) and a moveable menu item focus (18 in FIG. 1),<sup>10</sup> and

after the menu (12) has been opened and while the menu is being opened,<sup>11</sup> to keep the pointer stationary,<sup>12</sup> regardless of operation of the pointing device,<sup>13</sup> at the position the pointer was in when the menu was opened, while enabling the menu item focus to be moveable within the menu by means of the pointing device without moving the pointer.<sup>14</sup>

The invention of **independent claim 21** is directed to a method of enabling a user of a graphical user computer interface (10 in FIG. 1) to open at least one menu (12 in FIG. 1) and to select an item (14 in FIG. 1) of the menu (12) by means of a pointing device (30 in FIG.

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<sup>6</sup> Specification at page 9, lines 28-29, page 12, lines 27-29, page 15, lines 13-14 and 25-27 as well as FIG. 4.

<sup>7</sup> Specification at page 8, lines 20-23.

<sup>8</sup> Specification at page 16, lines 11-14.

<sup>9</sup> Specification at page 16, lines 8-14 and page 7, lines 15-17.

<sup>10</sup> Specification at page 7, lines 15-17 and page 8, lines 22-23.

<sup>11</sup> Specification at page 9, lines 28-29, page 12, lines 27-29, page 15, lines 13-14 and 25-27 as well as FIG. 4.

<sup>12</sup> Specification at page 12, lines 2-5.

<sup>13</sup> Specification at page 8, lines 20-28, FIGs. 2a-2c and the corresponding text at page 13, lines 14-17, and FIGs. 3a-3c and the corresponding text at page 14, lines 14-16.

<sup>14</sup> Specification at page 8, lines 20-23.

5).<sup>15</sup> The pointing device (30) has a two-dimension actuator (FIG. 7)<sup>16</sup> and a one-dimension actuator (32 in FIG. 6a)<sup>17</sup> and controls a moveable pointer (16 in FIG. 1) and a moveable menu item focus (18 in FIG. 1).<sup>18</sup> The method comprises:

when the menu (12) is not opened, controlling movements of the pointer (16) with the two-dimension actuator (FIG. 7),<sup>19</sup> and

when the menu (12) is opened, activating the one-dimension actuator (32) to control movement of the menu item focus (18) within the menu (12),<sup>20</sup> while enabling the two-dimension actuator (FIG. 7) to control movements of both the menu item focus (18) and the pointer (16) within the menu (12).<sup>21</sup>

The invention of **independent claim 22** is directed to a method of enabling a user of a graphical user computer interface (10 in FIG. 1) to open at least one menu (12 in FIG. 1) and to select an item (14 in FIG. 1) of the menu (12) by means of a pointing device (30 in FIG. 5).<sup>22</sup> The method comprises:

controlling a moveable pointer (16 in FIG. 1) and a moveable menu item (18 in FIG. 1) focus by the pointing device (30),<sup>23</sup>

after having opened the menu (12) and while the menu (12) is being opened,<sup>24</sup> enabling the menu item focus (18) to be moved within the menu (12) by means of the pointing device (30) while disabling the pointing device (30) from moving the pointer (16).<sup>25</sup>

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<sup>15</sup> Specification at page 16, lines 8-14 and page 7, lines 15-17.

<sup>16</sup> Specification at the paragraph bridging pages 16-17 and page 8, lines 10-11.

<sup>17</sup> Specification at page 12, lines 20-25 and page 8, line 12.

<sup>18</sup> Specification at page 7, lines 15-17 and page 8, lines 22-23.

<sup>19</sup> U4 and U1 in FIG. 4 and the corresponding text in the specification at page 15, lines 9-13 and 25-27, as well as page 16, lines 4-5.

<sup>20</sup> Specification at page 4, lines 21-22.

<sup>21</sup> Specification at page 9, lines 22-25 and page 10, lines 8-12.

<sup>22</sup> Specification at page 16, lines 8-14 and page 7, lines 15-17.

<sup>23</sup> Specification at page 7, lines 15-17 and page 8, lines 22-23.

<sup>24</sup> Specification at page 9, lines 28-29, page 12, lines 27-29, page 15, lines 13-14 and 25-27 as well as FIG. 4.

<sup>25</sup> Specification at page 8, lines 20-23.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

### **A. First Ground of Rejection**

The rejection of claims 1-5 and 8-22 under *35 U.S.C. 102(b)* as being anticipated by *Rosenberg* (U.S. Patent No. 6,128,006).

### **B. Second Ground of Rejection**

The rejection of claims 7, 23-24 under *35 U.S.C. 103(a)* as being unpatentable over *Rosenberg*.

## **VII. ARGUMENT**

### **A. First Ground of Rejection**

#### ***35 U.S.C. 102(b) rejection of claims 1-5 and 8-22 as being anticipated by Rosenberg***

The Examiner rejects claims 1-5 and 8-22 under *35 U.S.C. 102(b)* as being anticipated by *Rosenberg*. Appellant respectfully traverses this rejection.

#### **Independent Claim 10**

The *35 U.S.C. 102(b)* rejection of independent claim 10 is clearly erroneous, because the reference, as applied by the Examiner, fails to teach or disclose each and every element of the rejected claim, e.g., “the pointer stays at the position it was in when the menu was opened, while the menu item focus is moveable within the menu by means of the pointing device without moving the pointer.”

The Examiner’s reliance<sup>26</sup> on column 17 lines 30-38 of *Rosenberg* for the above feature of claim 10 is noted. Appellant respectfully disagrees with the Examiner’s holding that the cited

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<sup>26</sup> See final Office Action at page 4, the last line.

portion of *Rosenberg* teaches the claim feature. The cited passage of *Rosenberg* is reproduced below for the Board's convenience of review:

For example, one standard GUI feature is a pull-down menu 206. Individual menu items 208 in the pull down menu 206 may be selected by the user using cursor 204. Once the pull-down menu has been displayed, the selection of a menu item 208 can be controlled by wheel 16 moving cursor 204 (and, optionally, vertical motion of mouse 12 or 32 can be disabled while the menu is displayed). For example, a menu item selection bar 210 (or highlighter) can be moved up or down menu 206 by rotating the wheel 16...

A person of ordinary skill in the art upon reading the cited passage (especially the above highlighted teaching) would understand that the wheel 16, while controlling highlighter 210, also controls cursor 204<sup>27</sup> which the Examiner regards as the claimed pointer.<sup>28</sup> Thus, if wheel 16 of *Rosenberg* is operated by a user to control up-and-down movements of highlighter 210, cursor/pointer 204 should also be moved up and down at the same time, contrary to the claim limitation that the pointer is not moved.

The above teaching of *Rosenberg* is also consistent with his disclosure else where in the specification of the patent. For example, at column 19 line 55, *Rosenberg* discloses that

$$Y_{\text{CURSOR}} = Y_{\text{MOUSE}} + Y_{\text{WHEEL}}.$$

Thus, when a menu is opened, the Y position of the mouse can be ignored,<sup>29</sup> making

$$Y_{\text{CURSOR}} = Y_{\text{WHEEL}}.$$

It is apparent to the person of ordinary skill in the art that, again, the user's manipulation of the wheel 16 to move highlighter 210 up or down (i.e., changing  $Y_{\text{WHEEL}}$ ) will necessarily change  $Y_{\text{CURSOR}}$  and, hence, move cursor/pointer 204 up or down, contrary to the claim limitation that the pointer is not moved.

Thus, *Rosenberg*, as applied by the Examiner, does not teach or disclose, at least, the above-discussed feature of independent claim 10.

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<sup>27</sup> See *Rosenberg* at Fig. 9 and column 16 lines 54-55.

<sup>28</sup> See Final Office Action at page 4, line 6 from bottom.

<sup>29</sup> See *Rosenberg* at column 20 lines 6-10 and column 17 lines 35-36.



The Examiner's response <sup>30</sup> to Appellant's above argument is noted. Appellant respectfully disagrees with the Examiner's response for the following reasons.

With respect to the Examiner's argument that the prior art "does not eliminate the alternative function of the mouse wheel to only control the highlighter, without moving the pointer," <sup>31</sup> Appellant respectfully submits that such argument is not proper under *35 U.S.C. 102* which requires that "the reference must teach every element of the claim" either explicitly or implicitly.<sup>32</sup> "Does not eliminate" does not meet any of the explicit and implicit teaching standards under *35 U.S.C. 102*.

In addition, the reference, as applied by the Examiner, does not explicitly teach the claim limitation. Rather, *Rosenberg* explicitly teaches the opposite arrangement, i.e., the wheel moves the pointer/cursor, as argued above.

The Examiner has also failed to prove that the reference discloses the claim limitation through inherency by providing "a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."<sup>33</sup> The Examiner's analysis <sup>34</sup> of the reference's teachings shows, if at all, only that the movement of the wheel can be independent of the mouse, and that vertical motion of the mouse can be disabled while the menu is being displayed. The Examiner's analysis, however, has failed to show that the movement of the pointer/cursor can be independent of the wheel which is deemed necessary for a showing of inherency of the claim limitation. In *Rosenberg*, as applied by the Examiner, even when vertical motion of the mouse is disabled and movement of the wheel is made independent of the mouse, the cursor/pointer 204 can still be moved by the wheel, rather than staying where it was when the menu was opened as presently claimed.

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<sup>30</sup> See Final Office Action at page 11.

<sup>31</sup> See Final Office Action at page 11, lines 8-10 from bottom.

<sup>32</sup> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

<sup>33</sup> *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

<sup>34</sup> See Final Office Action at page 11, lines 1-8 from bottom.

In addition, since *Rosenberg* does not disclose disabling horizontal motion of mouse 12/32, it is inherent that cursor 204 is still moveable horizontally by mouse 12/32 after the menu is opened. Thus, the reference, as applied by the Examiner, fails to teach or disclose that the pointer/cursor stays where it was when the menu was opened.

For any of the reasons presented above, Appellant respectfully submit that *Rosenberg*, as applied by the Examiner, does not anticipate, either explicitly or implicitly, the invention of claim 10, and requests that the anticipatory rejection of claim 10 be reversed.

Claims 1-5, 8-9 and 11-16 which depend on claim 10, and claims 17-20 which include limitations similar to those of claim 10, are not anticipated by *Rosenberg*, as applied by the Examiner, for at least the reasons advanced with respect to claim 10.

#### Claim 2

As to claim 2, *Rosenberg*, as applied by the Examiner, fails to teach or disclose that “while the menu is being opened, none of the two-dimension actuator and one-dimension actuator control movements of the pointer.”

In *Rosenberg*, when the menu 206 is being opened, the one-dimension actuator or wheel 16 still controls movements of the pointer/cursor 204.<sup>35</sup>

The Examiner’s response<sup>36</sup> to Appellant’s above argument is noted. Appellant respectfully disagrees with the Examiner’s response because, again, Examiner has failed to prove that the reference discloses the claim limitation through inherency by providing “a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”<sup>37</sup> There is no basis in fact and/or technical reasoning to reasonably support the Examiner’s allegation that there is at least a fraction of time delay in which neither of the actuators has control over the movement of the pointer/cursor. It could be well the opposite, i.e., both of the actuators has control over the

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<sup>35</sup> *Rosenberg* at column 17 line 34.

<sup>36</sup> See Final Office Action at page 12, the second full paragraph.

<sup>37</sup> *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

movement of the pointer/cursor. It is clear to a person of ordinary skill in the art that the claim feature does not necessarily flow from the teachings of *Rosenberg*, as applied by the Examiner.

Thus, claim 2 is not anticipated by *Rosenberg*, as applied by the Examiner, is separately patentable on its own merit, and does not stand or fall together with the other claims.

Claim 15

As to claim 15, *Rosenberg*, as applied by the Examiner, fails to teach or disclose that the menu is closed by (i) a relative movement of the menu item focus out of the menu, by (ii) operating the two-dimension actuator, or by (iii) selecting a menu closing item with the two-dimension actuator.”

The Examiner alleges<sup>38</sup> that *Rosenberg* allows one- or two-dimension actuator to select a menu item without citing any teaching of *Rosenberg* in support of the allegation. The Examiner’s allegation, and hence, the rejection is improper as being evidentially unsupported.

Appellant further submits that *Rosenberg* does not teach any of the features (i)-(iii) of claim 15.

As to (i), the reference is silent on whether the menu can be closed by a relative movement of the menu item focus out of the menu. The reference, as applied by the Examiner, discloses only a menu exit item in FIG. 9.

As to (ii) and (iii), the reference does not teach both (a) an arrested pointer as recited in independent claim 10 from which claim 15 depends, and (b) closing the menu by operating or with the two-dimension actuator as recited in claim 15. *Rosenberg*, as applied by the Examiner, does not teach that the two-dimension actuator or mouse 12/32 can control movement of the focus 210. Thus, if *Rosenberg* was to close the menu with or by operating the two-dimension actuator or mouse 12/32, as recited in claim 15, it would have been necessary to use and move cursor 204, contrary to the requirement of claim 10 that the pointer stay where it was.

Thus, claim 15 is not anticipated by *Rosenberg*, as applied by the Examiner, is separately patentable on its own merit, and does not stand or fall together with the other claims.

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<sup>38</sup> See Final Office Action at page 5, lines 1-2 from bottom.

Independent claim 20

The 35 U.S.C. 102(b) rejection of independent claim 20 is clearly erroneous, because the reference, as applied by the Examiner, fails to teach or disclose each and every element of the rejected claim, e.g., “after the menu has been opened and while the menu is being opened, to keep the pointer stationary, regardless of operation of the pointing device, at the position said pointer was in when the menu was opened, while enabling the menu item focus to be moveable within the menu by means of the pointing device without moving the pointer.”

In *Rosenberg*, as applied by the Examiner, the cursor 204 is not kept stationary regardless of operation of the pointing device or mouse 12/32. In particular, when the vertical motion of mouse 12/32 is disabled, cursor 204 can still be moved vertically by wheel 16 which is part of the pointing device or mouse 12/32 or horizontally by mouse 12/32 (since *Rosenberg* does not disclose disabling horizontal motion of mouse 12/32). If *Rosenberg* is interpreted so that wheel 16 is not readable on the claimed pointing device, the reference so interpreted would fail to meet another feature of claim 20, i.e., “to enable said pointing device to control a moveable pointer and a moveable menu item focus.”

Accordingly, Appellant respectfully submit that *Rosenberg*, as applied by the Examiner, does not anticipate, either explicitly or implicitly, the invention of claim 20.

Claim 20 is thus separately patentable on its own merit, and does not stand or fall together with the other claims.

Claim 19 which depends on claim 20 is not anticipated by *Rosenberg*, as applied by the Examiner, for at least the reasons advanced with respect to claim 20.

Independent claim 21

The 35 U.S.C. 102(b) rejection of independent claim 21 is clearly erroneous, because the reference, as applied by the Examiner, fails to teach or disclose each and every element of the rejected claim, e.g., “when the menu is opened, activating the one-dimension actuator to control movement of the menu item focus within the menu, while enabling the two-dimension actuator to control movements of both the menu item focus and the pointer within the menu.”

In *Rosenberg*, there is no disclosure that highlighter 210 is controllable by mouse 12/32, or that cursor 204 is controllable by mouse 12/32 within menu 206, as presently claimed.

The Examiner's response<sup>39</sup> to Appellant's above argument is noted. Appellant respectfully disagrees with the Examiner for the following reasons.

The Examiner's allegation<sup>40</sup> that "*Rosenberg* further states that the mouse can control the cursor for selection of a menu item" is evidentially unsupported, because the Examiner has failed to cite any teaching of *Rosenberg* in support of the allegation. In addition, the Examiner's allegation is inaccurate, because a menu item is selectable only after the menu has been opened, and in *Rosenberg*, as applied by the Examiner, after the menu has been opened, the mouse is disabled and it is the wheel that has exclusive control of the cursor's position.<sup>41</sup> Even if the mouse is not disabled after the menu has been opened, there is still no disclosure in *Rosenberg* that teaches enabling the mouse to control highlighter 210 in the presently claimed manner.

The Examiner's subsequent analysis<sup>42</sup> of *Rosenberg*'s column 19 line 45 through column 20 line 24 is not on point. It should be noted that the claim language requires that the two-dimension actuator be enabled when the menu is opened to control movements of both the menu item focus and the pointer within the menu. In the Examiner's cited passage, the mouse apparently regarded by the Examiner as the claimed two-dimension actuator<sup>43</sup> is disabled. No where in the reference does *Rosenberg* teach or disclose that, when the menu is opened, the mouse 12/32 is enabled to control both the highlighter 210 and the cursor 204 within the menu 206 as presently claimed.

Accordingly, Appellant respectfully submits that *Rosenberg*, as applied by the Examiner, does not anticipate the invention of claim 21, and requests that the rejection of claim 21 be reversed.

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<sup>39</sup> See Final Office Action at page 12, the last two paragraphs.

<sup>40</sup> See Final Office Action at page 12, line 4 from bottom.

<sup>41</sup> See, *Rosenberg* at, e.g., column 20 lines 5-6 and 8-9.

<sup>42</sup> See Final Office Action at page 12, lines 1-3 from bottom.

<sup>43</sup> See, for example Final Office Action at page 8, line 4.

Claim 21 is thus separately patentable on its own merit, and does not stand or fall together with the other claims.

Independent claim 22

The 35 U.S.C. 102(b) rejection of independent claim 22 is clearly erroneous, because the reference, as applied by the Examiner, fails to teach or disclose each and every element of the rejected claim, e.g., “after having opened the menu and while the menu is being opened, enabling the menu item focus to be moved within the menu by means of the pointing device while disabling the pointing device from moving the pointer.”

In *Rosenberg*, the pointing device, particularly wheel 16, is not disabled from moving cursor 204. If *Rosenberg* is interpreted so that wheel 16 is not part of the pointing device, the reference so interpreted would fail to meet another feature of claim 22, i.e., “enabling the menu item focus to be moved within the menu by means of the pointing device.”

Accordingly, Appellant respectfully submits that *Rosenberg*, as applied by the Examiner, does not anticipate the invention of claim 22, and requests that the rejection of claim 22 be reversed.

Claim 22 is thus separately patentable on its own merit, and does not stand or fall together with the other claims.

Conclusion

For the extensive reasons shown above, Appellant respectfully requests that the anticipatory rejection relying on *Rosenberg* be reversed.

**B. Second Ground of Rejection**

35 U.S.C. 103(a) rejection of claims 7 and 23-24 as being unpatentable over Rosenberg

The 35 U.S.C. 103(a) rejection is traversed at least for the reasons advanced above with respect to independent claims 10 and 21 from which claims 7, 23, and 24 depend.

Claim 7

As to claim 7, *Rosenberg* as applied by the Examiner fails to teach or suggest the claim feature that “the menu is closed by a relative movement of the menu item focus out of the menu.”

The Examiner’s obviousness rejection<sup>44</sup> is traversed as being evidentially unsupported, because the Examiner has failed to cite any teaching or suggestion in the art or *Rosenberg* in support of his holding of obviousness.

In addition, the Examiner has failed to provide a clear articulation of the reason(s) why a person of ordinary skill in the art would have modified the reference to arrive at the claimed invention.<sup>45</sup>

Finally, it was only known in the art prior to the present invention that when the user scrolls past the last menu item, the highlighter/menu item focus will be cycled back to the top menu item.<sup>46</sup> There is no evidence that the claimed arrangement (i.e., the menu is closed when the menu item focus is moved out of the menu) was known in the art before the present invention, and therefore, a person of ordinary skill in the art would not have had no reason to modify *Rosenberg* to include the claimed arrangement.

Accordingly, Appellant respectfully submits that *Rosenberg*, as applied by the Examiner, does not render obvious the invention of claim 7, and requests that the rejection of claim 7 be reversed.

Claim 7 is thus separately patentable on its own merit, and does not stand or fall together with the other claims.

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<sup>44</sup> See Final Office Action at page 9, the last full paragraph.

<sup>45</sup> “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396.

<sup>46</sup> Commonly observed in popular software, such as, Internet Explorer, Microsoft(R) Word etc.

Claim 24

As to claim 24, *Rosenberg* as applied by the Examiner fails to teach or suggest the claim feature that “the menu closing item is positioned within the menu at a place unreachable by the one-dimension actuator.”

The Examiner’s obviousness rejection<sup>47</sup> is traversed, because the Examiner has failed to address the claimed “unreachable” feature. The Examiner argues that it would have been obvious to arrange the menu closing item at a place reachable/selectable by the mouse pointer. It is, however, unclear from the Examiner’s rationale why<sup>48</sup> a person of ordinary skill in the art would have also placed such selectable-by-pointer menu exit item at a place unreachable by the wheel/menu item focus 210. A *prima facie* case of obviousness has not been established because the reference as modified by the Examiner would still lack the highlighted claim feature.<sup>49</sup>

The Examiner<sup>50</sup> appears to argue that a menu closing item is unreachable by the wheel if the wheel (one-dimension actuator) is not provided. The Examiner’s argument should fall, because the *Rosenberg* device/method, which does not include a wheel (one-dimension actuator), would fail to meet the requirement of claim 21 (from which claim 24 depends) that an one-dimension actuator be activated (and hence, present) when the menu is opened.

Accordingly, Appellant respectfully submits that *Rosenberg*, as applied by the Examiner, does not render obvious the invention of claim 24, and requests that the rejection of claim 24 be reversed.

Claim 24 is thus separately patentable on its own merit, and does not stand or fall together with the other claims.

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<sup>47</sup> See Final Office Action at page 10, the first full paragraph.

<sup>48</sup> “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396.

<sup>49</sup> See, e.g., Fig. 9 of *Rosenberg*, i.e., all menu items 208 of menu 206, including “Exit,” is reachable, rather than unreachable, by wheel 16.

<sup>50</sup> See, May 21, 2007 Final Office Action at, e.g., page 14, lines 6-10.



Conclusion

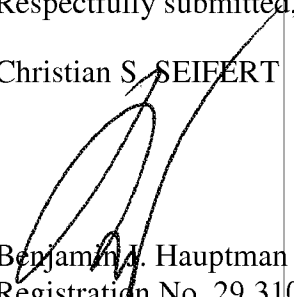
For the reason shown above, Appellant respectfully requests that the obviousness rejection relying on *Rosenberg* be reversed.

Each of the Examiner's rejections has been traversed. Accordingly, Appellant respectfully submits that all claims on appeal are considered allowable. Accordingly, reversal of the Examiner's Final Rejection is believed appropriate and courteously solicited.

If for any reason this Appeal Brief is found to be incomplete, or if at any time it appears that a telephone conference with counsel would help advance prosecution, please telephone the undersigned, Appellant's attorney of record.

Respectfully submitted,

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## **VIII. CLAIMS APPENDIX**

1. The graphical user computer interface of claim 10, wherein said pointing device comprises a two-dimension actuator and a one-dimension actuator,  
the interface is arranged such that the two-dimension actuator controls movements of the pointer when said menu is not opened, and  
the one-dimension actuator is activated, when the menu is opened, to control movement of the menu item focus within the menu.
2. The graphical user computer interface of claim 1, arranged such that, while the menu is being opened, none of the two-dimension actuator and one-dimension actuator control movements of the pointer.
3. The graphical user computer interface of claim 1, arranged such that the menu is opened by positioning the pointer on a displayed element, associated with the menu, with or without clicking on the element.
4. The graphical user computer interface of claim 1, arranged such that the menu item is activated by positioning the focus thereon, with or without clicking on the menu item.
5. The graphical user computer interface of claim 1, arranged such that an operational shift from a pointer modus to a menu item focus modus is activated automatically upon opening of the menu.
7. The graphical user computer interface of claim 1, arranged such that the menu is closed by a relative movement of the menu item focus out of the menu.

8. The graphical user computer interface of claim 1, arranged such that an operation modus shifts from a menu item focus modus back to a pointer modus upon closing of the menu.

9. The graphical user computer interface of claim 1, wherein the one-dimension actuator is a wheel.

10. A graphical user computer interface enabling a user to open at least one menu and to select an item of the menu by means of a pointing device, said pointing device controlling a moveable pointer and a moveable menu item focus,

wherein the interface is arranged such that, after the menu has been opened, the pointer stays at the position it was in when the menu was opened, while the menu item focus is moveable within the menu by means of the pointing device without moving the pointer.

11. The graphical user computer interface of claim 10, arranged such that the menu is opened by positioning the pointer on a displayed element, associated with the menu, with or without clicking on the element.

12. The graphical user computer interface of claim 10, arranged such that the menu item is activated by positioning the focus thereon, with or without clicking on the menu item.

13. The graphical user computer interface of claim 10, arranged such that an operational shift from a pointer modus to a menu item focus modus is activated automatically upon opening of the menu.

14. The graphical user computer interface of claim 10, arranged such that the menu item focus is movable while the menu is fixed or the menu item focus is fixed while the menu is movable, by operating the pointing device.

15. The graphical user computer interface of claim 10, arranged such that the menu is closed by a relative movement of the menu item focus out of the menu, by operating the two-dimension actuator, or by selecting a menu closing item with the two-dimension actuator.

16. The graphical user computer interface of claim 10, wherein the pointing device is a computer-mouse.

17. The computer of claim 18, wherein  
said pointing device comprises a two-dimension actuator and a one-dimension actuator,  
the interface is arranged such that the two-dimension actuator controls movements of the pointer when said menu is not opened, and  
the one-dimension actuator is activated, when the menu is opened, to control movement of the menu item focus within the menu.

18. A computer comprising a display and a pointing device, wherein  
said computer is programmed to provide a graphical user interface enabling a user to open at least one menu in the display and to select an item of the menu by means of the pointing device,  
the pointing device controls a moveable pointer and a moveable menu item focus, and  
after the menu has been opened and while the menu is being opened, the pointer stays at the position the pointer was in when the menu was opened, while the menu item focus is moveable within the menu by means of the pointing device without moving the pointer.

19. The computer-readable medium of claim 20, wherein  
said pointing device comprises a two-dimension actuator and a one-dimension actuator, and  
the program code, when executed on the computer system, is arranged  
to enable the two-dimension actuator to control movements of the  
pointer when said menu is not opened, and

to activate the one-dimension actuator when the menu is opened to control movement of the menu item focus within the menu.

20. A computer-readable medium containing thereon program code which, when executed on a computer system, is arranged

to enable a user to open at least one menu in a display of said computer system and to select an item of the menu by means of a pointing device of said computer system,

to enable said pointing device to control a moveable pointer and a moveable menu item focus, and

after the menu has been opened and while the menu is being opened, to keep the pointer stationary, regardless of operation of the pointing device, at the position said pointer was in when the menu was opened, while enabling the menu item focus to be moveable within the menu by means of the pointing device without moving the pointer.

21. A method of enabling a user of a graphical user computer interface to open at least one menu and to select an item of the menu by means of a pointing device, said pointing device having a two-dimension actuator and a one-dimension actuator and controlling a moveable pointer and a moveable menu item focus, said method comprising:

when the menu is not opened, controlling movements of the pointer with the two-dimension actuator, and

when the menu is opened, activating the one-dimension actuator to control movement of the menu item focus within the menu, while enabling the two-dimension actuator to control movements of both the menu item focus and the pointer within the menu.

22. A method of enabling a user of a graphical user computer interface to open at least one menu and to select an item of the menu by means of a pointing device, said method comprising:

controlling a moveable pointer and a moveable menu item focus by the pointing device,

after having opened the menu and while the menu is being opened, enabling the menu item focus to be moved within the menu by means of the pointing device while disabling the pointing device from moving the pointer.

23. The graphical user computer interface of claim 1, arranged such that the menu is closed by selecting a menu closing item within the menu with the one-dimension actuator or the two-dimension actuator,

wherein said menu closing item, when selected, only causes closing of said menu.

24. The method of claim 21, further comprising  
closing the menu by selecting a menu closing item with the pointer controlled by the two-dimension actuator,

wherein the menu closing item is positioned within the menu at a place unreachable by the one-dimension actuator.

**IX. EVIDENCE APPENDIX**

None

**X. RELATED PROCEEDINGS APPENDIX**

None